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454178—58

In the Supreme Court of the United States

OCTOBER TERM, 1957

No. 711

PETROCARBON LIMITED, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The decisions of the Patent Office Examiner and the Board of Appeals of the United States Patent Office (R. 44–54; Pet. App. 2a–8a) are unreported. The memorandum opinion of the United States District Court for the District of Columbia (Pet. App. 9a) is unreported. The opinions of the United States Court of Appeals for the District of Columbia Circuit (Pet. App. 11a) are reported at 247 F. 2d 800.

JURISDICTION

The judgment of the Court of Appeals was entered on July 3, 1957 (R. 66). The petition for rehearing, filed on July 29, 1957, pursuant to an extension

granted under Rule 31 (k) (2) of that court's rules, was denied on October 9, 1957. The petition for a writ of certiorari was filed on January 7, 1958. The jurisdiction of this Court is invoked under 28 U. S. C. 1254 (1).

QUESTION PRESENTED

Whether the Patent Office and both courts below properly rejected petitioner's patent application for failure to describe a use for the claimed invention.

STATUTES INVOLVED

Sections 112 and 145 of Title 35 of the United States Code provide, in pertinent part, as follows:

> § 112. SPECIFICATION
>
> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> § 145. CIVIL ACTION TO OBTAIN PATENT
>
> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge

that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

STATEMENT

This action to obtain a patent was commenced in April, 1954, under 35 U. S. C. 145, against the Commissioner of Patents, by the petitioner Petrocarbon Limited, an English corporation and assignee of Michael Mojzesz Szwarc, an English subject and inventor of the process in question. The Patent Office Examiner rejected the patent application because the specification therein failed to describe a utility as required by 35 U. S. C. 112. The Examiner's decision was affirmed by the Board of Appeals of the Patent Office.

The District Court, concluding that "the ruling of the Patent Office should remain * * * undisturbed," dismissed petitioner's complaint (Pet. App. 10a). The Court of Appeals affirmed, noting that since the specification failed to show "how utility could in fact be achieved" it was "defective as a matter of law" (Pet. App. 13a, 14a). Judge Burger dissented (Pet. App. 14a).

1. *The Szwarc application.*—The application related to a process for producing a solid polymer of paraxylene. The polymer, a material having a molecule consisting of a plurality of paraxylene units chemically

bound together, was produced by heating paraxylene vapors at a temperature of about 860° Centigrade for a period of about 0.3 to 0.4 seconds while under a pressure of from about 8 to 10 millimeters of mercury, and cooling the vapors to a temperature at which a solid polymer was deposited (R. 23–27).

Szwarc's specification in his application described the resulting polymers as "new and useful," and as solids. The specification further stated that the resulting polymer was a white film, sometimes transparent, possessed of "great thermal stability," resistant to sulphuric acid, and insoluble in and not swollen by various named substances (R. 26–27).

2. *Proceedings below.*—Szwarc's application, as already noted, was refused by the Patent Office Examiner on the ground that the specification did not adequately set forth any use for the polymer. His decision was affirmed by the Patent Office Board of Appeals, and a petition for reconsideration by the Board was denied.

Thereafter, petitioner brought the present suit under 35 U. S. C. 145 in the district court to compel the Commissioner of Patents to issue the patent. At a trial *de novo,* both parties agreed (R. 8, 12) with the court that the only issue was whether "[t]he claims which have been rejected comply with the terms of the statute with respect to what should be contained in the specification" (R. 13). Since the sole question required only a determination of whether the applicant's specification conformed with 35 U. S. C. 112, the court stated to the parties, "Give me the spec-

ification. I have the statute. I will examine it and make up my own mind, and I don't need any evidence" (R. 12). However, the court permitted petitioner to introduce various exhibits showing the formation of the film (R. 13). At no time did petitioner expressly request that any witnesses be allowed to testify, although petitioner's counsel did state that "the only purpose of our witnesses was to explain what the term film meant, and to show this exhibit is made in conformity with the specification, and that they did actually protect, and were functional" (R. 17).

ARGUMENT

Petitioner seeks by this action to compel the Commissioner of Patents to issue to it a patent covering a chemical process for the production of a certain polymer. Both courts below, as well as the Patent Office in the first instance, have ruled that petitioner's patent application failed to specify or describe "how the product is to be used" (Pet. App. 14a). In so ruling, these tribunals applied the correct standards and requirements of the controlling statute to the particular application before them. Further review by this Court, we submit, is not warranted.

1. The explicit terms of 35 U. S. C. 112 require the patent application specification to describe "in full, clear, concise, and exact terms," to those skilled in the art, "the manner and process of making and using" the product. In the present case, the Patent Examiner, the Board of Appeals of the Patent Office, the District Court, and the Court of Appeals, all con-

cluded that the patent application did not satisfy the statutory requirements.[1] Petitioner seems to challenge the decisions below principally on the ground that the testimony of persons skilled in the art should have been heard and considered by the District Court. The short and conclusive answer to this contention, as noted by the court below, is that the specification in no way explained how the polymer or film could be used (Pet. App. 14a). The specification, therefore, was defective as a matter of law. Of course, if the specification had indicated a particular use for the polymer or film, "testimony of experts might well have been received" to demonstrate to the District Court that "the language used was sufficient to explain this use to one skilled in the art" (Pet. App. 14a). But, since no particular use was specified, the expert testimony was properly excluded.

[1] Examination of the language of petitioner's patent specification confirms its inadequacy. Thus, the specification states that "Polymerisation takes place spontaneously on condensation of the monomer vapour by cooling. The cooling may take place in contact with a cool surface on which the polymer is deposited in the form of a film" (R. 24). It further asserts that the polymers were useful and "were not attacked by sulphuric acid as 150° C. [and that] They were insoluble in, and also did not swell visibly in" various named substances (R. 26). In other words, the specification described the process invented, and described the product resulting as a "film" possessing a limited number of resistant properties, and simply declared that the resulting product was useful. However, as the Court of Appeals properly observed, "it is not apparent from the face of the specification how utility could in fact be achieved" and there is no indication "whether or not this film adheres to the object on which it forms, whether it falls off in the form of a powder, whether it is detachable in the form of a filmlike substance (similar perhaps to cellophane), whether the film of polymer is useful as such,

In addition, it is well settled, notwithstanding petitioner's assertion to the contrary (Pet. 7), that "the words of a patent or a patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts." *Minnesota Mining and Manufacturing Co.* v. *Carborundum Co.*, 155 F. 2d 746, 749 (C. A. 3). Of course it is true that it is often wise and sometimes even necessary for the court to seek expert assistance to explain the meaning of technical language. *U. S. Industrial Chemicals, Inc.* v. *Carbide & Carbon Chemicals Corp.*, 315 U. S. 668, 678. However, "It is * * * for the trial judge to decide whether he needs the assistance of an expert to understand the patent * * *." *National Transformer Corp.* v. *France Manufacturing Co.*, 215 F. 2d 343, 358 (C. A. 6). In fact, once the judge has determined that he understands the words of the patent, expert testimony is, as one Court of Appeals labeled it, "a burdensome impertinence." *Kohn* v. *Eimer*, 265 Fed. 900, 902 (C. A. 2) (where the issues were infringement and anticipation).

2. There is, we believe, no merit to petitioner's assertion that the problem presented is "of general and fundamental importance in the administration of the United States patent laws" (Pet. 6). The problem is of no general significance because it can be avoided by definite, complete and detailed specifications in conformity with the statutory test of specificity. The failure to meet that requirement means that the public will

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whether it would have to be subjected to further processing before it could form a useful object or fluid, and so on." (Pet. App. 13a.)

not be on notice of the invention and may innocently infringe upon it, or at the expiration of the patent the public may not exploit the invention because it is unaware of the use to which it could be put. See *Schriber-Schroth Co.* v. *Cleveland Trust Co. et al.*, 311 U. S. 211; *In re Bremner*, 37 C. C. P. A. (Patents) 1032, 182 F. 2d 216.[2]

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[2] Equally lacking in merit are petitioner's other two arguments. (1) Petitioner was not deprived of its property without due process of law. While letters patent, once issued, are constitutionally protected property, *McCormick Machine Co.* v. *Aultman*, 169 U. S. 606; *Cramp & Sons* v. *Curtis Turbine Co.*, 246 U. S. 28, petitioner never secured letters patent. Prior to patent, an invention is not property, *Chemical Foundation* v. *General Aniline Works*, 99 F. 2d 276, and at most an inchoate right, *Mullins Manufacturing Co.* v. *Booth*, 125 F. 2d 660, 664, and, of course, denial of petitioner's patent application does not deprive petitioner of the right to exploit the Szwarc process. In addition, petitioner overlooks the full administrative hearing and review accorded it, together with the *de novo* proceeding in the District Court. (2) The need for maintaining "good international relations" does not call for issuance of a patent to petitioner. While it is true that 35 U. S. C. 119 grants to United States patent applications of foreign inventors the benefit of the earlier filing date of their foreign applications, the disclosure requirements of American patent law are in no way relaxed. In short, if the foreign inventor fulfills the conditions for obtaining a patent, the date of issuance may be retroactive. "[T]he sake of good international relations" certainly does not require that foreign inventors comply with lesser disclosure requirements than must be met by American inventors.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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